

02-01-2005 14:01 From: PILLSBURY WINTHROP

+703-905-2500

T-302 P.007/010 F-506

RAFIE et al. -- 09/764,202
Client/Matter: 011765-0302386

IN THE DRAWINGS:

Please replace Figure 1 with Figure 1 as shown on the enclosed copy of such figure.

RAFIE et al. -- 09/764,202
Client/Matter: 011765-0302386

REMARKS

Claims 1-43 are pending. By this Amendment, Figure 1 is amended. Reconsideration in view of the above amendments and following remarks is respectfully requested.

Figure 1 was objected to. Figure 1 has been amended in accordance with the suggestion of the Office Action. Reconsideration and withdrawal of the objection to Figure 1 are respectfully requested.

Claims 3-11, 14, 37-41 and 43 were rejected under 35 U.S.C. §112, first paragraph.

The rejection is respectfully traversed.

MPEP §2164.04 states: "In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention."

MPEP §2164.01 states: "Accordingly, even though the statue does not use the term 'undue experimentation,' it has been interpreted to require that the claimed invention be enabled so that any persons skilled in the art can make and use the invention without undue experimentation." MPEP §2164.01(a) lists the at least eight factors that must be considered by the examiner when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is undue. MPEP §2164.01(a) states" "It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole." (Emphasis added.)

It is respectfully submitted that that the Examiner has not met the initial burden to establish a reasonable basis to question enablement of the claimed invention. In particular, it is respectfully noted that the Examiner has not analyzed even one of the factors required by MPEP §2164.01(a). However, in order to expedite prosecution of the application, the following explanations are provided.

With respect to page 2, paragraph number 5 of the Office Action, the term "invitation burst" is used throughout the specification. For example, the description of Figure 6 at page 26, line 9, refers to the term "invitation burst."

With respect to page 2, paragraph number 6 of the Office Action, the removal of modulated signals is clearly disclosed on page 19, line 18+.

RAFIE et al. -- 09/764,202
Client/Matter: 011765-0302386

With respect page 3, paragraph number 7 of the Office Action, the join operation is clearly disclosed, for example, on page 8, lines 17-28, where it is clearly explained that two modes of operation are relevant for the mesh radio system to which the present invention can be applied. The first mode is "join mode" in which new mode is invited to join the mesh radio system. The situation also clearly covers a situation where a mesh of interconnected modes exists and a new subscriber wishes to join that mesh.

Reconsideration and withdrawal of the rejection under 35 U.S.C. §112, first paragraph are respectfully requested.

Claims 1, 2 and 15-18 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claim 26 of U.S. Patent Application Publication 2002/0196844 A1 now U.S. Patent 6,628,707. The rejection is respectfully traversed.

The filing date of the instant application is January 17, 2001. The filing date of U.S. Patent Application 2002/0196844 A1 is May 4, 2001. As set forth in MPEP §804II.B.1(b), as U.S. Patent Application Publication 2002/0196844 A1 is the later filed application, a two-way test must be applied to determine the appropriateness of a rejection under the judicially created doctrine of obviousness-type double patenting. In other words, the Examiner is required to show that the claims of the instant application are obvious variations of the claims of U.S. Patent Application Publication 2002/0196844 A1 and that the claims of U.S. Patent Application Publication 2002/0196844 A1 are an obvious variation of the claims of the instant application. As the Examiner has not performed this two-way test, it is respectfully submitted that the obviousness-type double patenting rejection is improper and must be withdrawn.

Reconsideration and withdrawal of the obviousness-type double patenting rejection are respectfully requested.

Applicants respectfully note that claims 20-36 and 42 have not been rejected under any grounds. Applicants respectfully submit that these claims are allowable.

It is also respectfully noted that although page 6, paragraph number 11 of the Office Action states that claim 12 is provisionally rejected, page 7, line 6 refers to claims 12 and 13. The Examiner is respectfully requested to clarify the status of claim 13.

An Information Disclosure Statement was filed May 6, 2003. Applicants have not yet received the initialed, signed and dated PTO-1449. The Examiner is respectfully requested to

RAFIE et al. -- 09/764,202
Client/Matter: 011765-0302386

consider each reference, initial, sign and date the PTO-1449 and return a copy of such with
the next Office Action in accordance with MPEP §609.

In view of the above amendments and remarks, Applicants respectfully submit that all
the claims are allowable and that the entire application is in condition for allowance.

Should the Examiner believe anything further is desirable to place the application in
better condition for allowance, the Examiner is respectfully requested to contact the
undersigned at the telephone number listed below.

Respectfully submitted,
PILLSBURY WINTHROP LLP


JOHN P. DARLING
Reg. No. 44482
Tel. No. (703) 905-2045
Fax No. (703) 907-2500

Date: February 1, 2005
P.O. Box 10500
McLean, VA 22102
(703) 905-2000

Attachment:

Replacement Sheet (Figure 2)